

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, new claim 25 has been added. Support for claim 25 can be found in the present specification, for example, page 7, lines 5-9. Claims 2-10, 12, 16-18, 20, 23 and 24 were previously cancelled. Upon entry of the Amendment, claims 1, 11, 13-15, 19, 21, 22 and 25 will be all the claims pending in the application.

I. Statement of Substance of Interview

Applicants wish to thank Examiner Wood for participating a telephone Interview on September 8, 2011. During the Interview, the Examiner's comments on page 4 of the Office Action (item 5) and the cited art were discussed.

II. Response to Rejection under 35 U.S.C. § 102(b)

Claims 1, 11, 13-15, 19, 21 and 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,179,168 (*Hirasawa*). Applicants respectfully traverse the rejection for the reasons of record and the following additional reasons.

Claim 1 recites a resin composition consisting essentially of, among others, 0.5 to 20 parts by weight of an ethylene-unsaturated ester copolymer (B) consisting of ethylene groups and unsaturated ester groups, wherein the unsaturated ester in the ethylene-unsaturated ester copolymer is a vinyl ester selected from the group consisting of vinyl acetate and vinyl propionate; or an unsaturated carboxylic acid ester selected from the group consisting of methyl acrylate, ethyl acrylate, isopropyl acrylate, isobutyl acrylate, n-butyl acrylate, isoctyl acrylate, 2-ethylhexyl acrylate, methyl methacrylate, ethyl methacrylate and isobutyl methacrylate.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For an anticipation to exist, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the present case, *Hirasawa* does not disclose each feature recited in independent claim 1, and as such fails to constitute an anticipation of such claim. For example, *Hirasawa* does not disclose a resin composition consisting essentially of 0.5 to 20 parts by weight of an ethylene-unsaturated ester copolymer (B) consisting of ethylene groups and unsaturated ester groups, as recited in claim 1.

Specifically, *Hirasawa* discloses a third ionomer which may include other monomer such as an unsaturated carboxylic acid ester or vinyl ester in an amount of up to about 20 mole%. It is noted that this third ionomer including the unsaturated carboxylic acid ester still contains carboxylic acid metal salt groups and free carboxylic acid groups which are the characteristic features of an ionomer. As such, this ionomer is different, and should have different behaviors, from the "copolymer (B)" consisting of ethylene and unsaturated ester recited in the present claims.

The Office Action provides the following comments:

In response, the examiner would like to direct the Applicant's attention to section 2111.03 of the MPEP. The MPEP states 'when the phrase 'consists of' appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole'. It is held that 'the transition language comprising' allows the claim to cover all ethylene-unsaturated ester copolymers, as long as the ethylene-unsaturated ethylene copolymer contains the specific ethylene group and unsaturated ester groups recited by the claims. Therefore, *Hirasawa* discloses employing an ethylene unsaturated ester (B) consisting of ethylene groups and unsaturated ester groups (col. 4 lines 34-37).

(page 4, 3rd paragraph of the Office Action).

The Examiner appears to misunderstand the cited statements of MPEP. As stated, the phrase "consists of" does limit the element set forth in the clause where the phrase appears. Applying this holding to the present case, the phrase "consists of" should be interpreted to limit the "copolymer (B)," which is in the clause as the phrase "consists of." However, the phrase "consists of" does not exclude other elements from the recited "resin composition."

During the Interview, the Examiner also mentioned *In re Crish*, 393 F.3d 1253, 73 USPQ2d 1364 (Fed. Cir. 2004).

In *In re Crish*, the claims at issue are directed to "a purified oligonucleotide comprising at least a portion of the nucleotide sequence of SEQ ID NO:1 wherein said portion consists of the nucleotide sequence from 1 to 2473 of SEQ ID NO:1, and wherein said portion of the nucleotide sequence of SEQ ID NO:1 has promoter activity." The court stated that the use of "consists" in the body of the claims did not limit the open-ended "comprising" language in the claims and held that the claimed promoter sequence designated as SEQ ID NO:1 was obtained by sequencing the same prior art plasmid and was therefore anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed oligonucleotides.

Particularly, the court held that "the transition phrase 'consists' did not limit the claims to only the recited numbered nucleotide sequences of SEQ ID NO:1" and that "the transition language 'comprising' allowed the claims to cover the entire involucrin gene plus other portions of the plasmid, as long as the gene contained the specific portions of SEQ ID NO:1 recited by the claim[s]."

It is noted that the decision in *In re Crish* is consistent with the above noted holding, i.e., when the phrase "consists of" appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not

excluded from the claim as a whole. Therefore, in *In re Crish*, the phrase "consists of" merely limits "said portion," and does not exclude other elements from the recited "oligonucleotide."

For at least the above reasons, it is apparent that independent claim 1 as well as dependent claims 11, 13-15, 19, 21 and 22 are not anticipated by, nor obvious over, *Hirasawa*. Accordingly, withdrawal of the above rejection is respectfully requested.

III. New Claim

Newly added claim 25 recites a resin composition consisting essentially of 5-50 parts by weight of a potassium ionomer (A) of an ethylene-unsaturated carboxylic acid copolymer comprising a potassium ionomer of two or more types of ethylene-unsaturated carboxylic acid copolymers which has an average acid content of 10 to 30 % by weight, has difference in acid contents between the highest content and the lowest content of 1 % by weight or more, and has a neutralization degree by potassium of 60 % or more, 0.5 to 20 parts by weight of an ethylene-unsaturated ester copolymer (B) consisting of ethylene groups and unsaturated ester groups, wherein a content of the unsaturated ester groups in the ethylene-unsaturated ester copolymer is 10 to 35% by weight, and wherein the unsaturated ester in the ethylene-unsaturated ester copolymer is an unsaturated carboxylic acid ester selected from the group consisting of acrylic acid esters and methylacrylic acid esters, and 94.5 to 30 parts by weight of a thermoplastic resin (C) other than (A) and (B), wherein the thermoplastic resin (C) is at least one resin selected from the group consisting of medium density polyethylene, high density polyethylene, polypropylene, poly-4-methyl-1-pentene and a combination thereof.

As noted above, *Hirasawa* does not disclose an ethylene-unsaturated ester copolymer (B) consisting of ethylene groups and unsaturated ester groups.

Further, when a potassium ionomer is blended in a polyolefin type resin having high crystallinity, widely used in the field of film and blow molded container, such as polyethylene,

especially high density polyethylene, and polypropylene, there are drawbacks such that torque of an extruder increases and productivity falls in molding processing due to poor dispersibility and compatibility of potassium ionomer and it is easy to cause bad-appearance of molded articles (see page 2, line 24 to page 3, line 5 of the present specification).

In the resin composition of the presently claimed invention, by employing the specific ethylene-unsaturated ester copolymer (B), dispersibility and compatibility of potassium ionomer with high crystalline polyolefin type resin are improved and melt torque of an extruder is reserved at low level, good-appearance of molded articles and high productivity are obtained without impairing antistatic properties of potassium ionomer.

Hirasawa does not disclose or suggest these unexpectedly excellent effects.

IV. Conclusion

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at his earliest convenience.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

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